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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,987	07/16/2003	Jackson Hsieh	2011118	1002

7590 06/29/2004

PRO-TECHTOR INTERNATIONAL  
20775 Norada Court  
Saratoga, CA 95070-3018

EXAMINER

SOWARD, IDA M

ART UNIT PAPER NUMBER

2822

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8

<b>Office Action Summary</b>	<b>Applicati n N .</b>	<b>Applicant(s)</b>	
	10/621,987	HSIEH ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ida M Soward	2822	

**-- The MAILING DATE of this communication appears n the cover sheet with the correspondence address --**  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 6 is/are rejected.
- 7) ☒ Claim(s) 2 and 5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is in response to the election filed April 16, 2004.

#### ***Election/Restrictions***

Applicant's election without traverse of claims 1-3 and 5-6 in the reply filed on April 16, 2004 is acknowledged.

#### ***Claim Objections***

Claims 5-6 are objected to because of the following informalities: the claims state "The method according to claim 1," when claim 1 is actually "A substrate structure". Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art Figure 1 in view of Spinelli et al. (4,472,762).

In regard to claims 1, 3 and 6, Admitted Prior Art Figure 1 teaches a substrate structure for an integrated circuit package to be electrically connected

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to a printed circuit board, the substrate structure comprising: a plurality of metal sheets 10 arranged in an array, each of the metal sheets having an upper surface 14 and a lower surface 12; an encapsulant 16 for encapsulating the metal sheets, wherein the upper surfaces of the metal sheets are exposed from the encapsulant, and the lower surfaces of the metal sheets are exposed from the encapsulant and electrically connected to the printed circuit board, wherein the encapsulant is made of a plastic material (pages 1-2, Description of the Related Art).

In regard to claim 6, concerning being made by way of injection molding, note that a "product by process" claim is directed to the product per se, no matter how actually made, In re Hirao, 190 USPQ 15 at 17 (footnote 3). See also In re Brown, 173 USPQ 685; In re Luck, 177 USPQ 523; In re Wertheim, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); In re Fitzgerald, 205 USPQ 594, 596 (CCPA); In re Marosi et al., 218 USPQ 289 (CAFC); and most recently, In re Thorpe et al., 227 USPQ 964 (CAFC, 1985) all of which make it clear that it is the final product per se which must be determined in a "product by process" claim, and not the patentability of the process, and that, as here, an old or obvious product produced by a new method is not patentable as a product, whether claimed in "product by process" claims or not. Note that Applicant has burden of proof in such cases as the above case law makes clear. As to the grounds of rejection under section 103, see MPEP § 2113.

However, Admitted Prior Art Figure 1 fail to teach a plurality of upper metal sheets arranged in an array, each of the upper metal sheets having an upper

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surface and a lower surface, the lower surfaces of the upper metal sheets being stacked on the upper surfaces of the lower metal sheets; and an encapsulant for encapsulating the metal sheets, wherein the upper surfaces of the metal sheets are exposed from the encapsulant, and the lower surfaces of the metal sheets are exposed from the encapsulant.

Spinelli et al. teach a plurality of upper metal sheets 56 arranged in an array, each of the upper metal sheets 56 having an upper surface and a lower surface, the lower surfaces of the upper metal sheets being stacked on the upper surfaces of the lower metal sheets; and an encapsulant 18 for encapsulating the upper metal sheets 56, wherein the upper surfaces of the upper metal sheets 56 are exposed from the encapsulant 18, and the lower surfaces of the upper metal sheets 56 are exposed from the encapsulant 18.

Since Admitted Prior Art Figure 1 and Spinelli et al. are from the same field of endeavor (substrate structures), the purpose disclosed by Spinelli et al. would have been recognized in the pertinent art of Admitted Prior Art Figure 1. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the substrate structure as taught by Admitted Prior Art Figure 1 with the substrate structure having a plurality of upper metals as taught by Spinelli et al. to provide the substrate with desired electrical conductivity, with desired thermal conductivity and expansion (col. 2, lines 16-22).

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***Allowable Subject Matter***

Claims 2 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following claims are cited to further show the state of the art with respect to substrate structures:

Glenn et al. (US 6,545,345 B1)

Lee (US 6,303,997 B1)

Russel et al. (%637,828)

Vaiyapuri (US 2002/0027271 A1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ida M Soward whose telephone number is 571-272-1845. The examiner can normally be reached on Monday - Thursday, 6:30 am to 5:00 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on 571-272-1852. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMS

June 24, 2004



**AMIR ZARABIAN**  
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